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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/332,863	06/15/99	IMPERIAL	REV-99-10

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IM52/0313

EXAMINER

MRUK, B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 03/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/332,863

Applicant(s)  
Imperial

Examiner  
Brian Mruk

Group Art Unit  
1751



☒ Responsive to communication(s) filed on Dec 8, 2000

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-3 and 5-68 is/are pending in the application.

Of the above, claim(s) 25-68 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-3 and 5-24 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

1. This Office action is in response to Applicant's amendment filed December 8, 2000. By amendment, applicant has amended claims 1, 5 and 15. Claim 4 has been canceled. New claims 21-68 have been added. Currently, claims 1-3 and 5-68 remain pending in the application.
2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office action, paper no. 3.
3. The rejection of claims 5-20 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendment. Specifically, applicant has amended claim 5 to replace the term "use" with "application" and has amended claim 15 to recite "30% of a silicone compound".
4. The rejection of claims 1-3 under 35 U.S.C. 102(b) as being anticipated by Hoyu, JP 9-067,235, is withdrawn in view of applicant's amendments. Specifically, applicant has amended claim 1 to require a cationic dye molecule.
5. The rejection of claims 1-3 under 35 U.S.C. 102(a) as being anticipated by Goldwell, DE 19721785, is maintained for the reasons of record.

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6. The rejection of claims 1-3, 5-14 and 16-20 under 35 U.S.C. 103(a) as being unpatentable over Goldwell, DE 19721785, is maintained for the reasons of record.

7. The rejection of claims 1-3 and 5-20 under 35 U.S.C. 103(a) as being unpatentable over Goldwell, DE 19721785, in view of Yoshihara, U.S. Patent No. 5,332,581, is maintained for the reasons of record.

8. The rejection of claims 5-8, 11 and 18-20 under 35 U.S.C. 103(a) as being unpatentable over Henkel, DE 2,624,690, is maintained for the reasons of record.

### **NEW GROUNDS OF REJECTION**

#### ***Constructive Election***

9. Newly submitted claims 25-68 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

A. Restriction to one of the following inventions would have been required under 35 USC 121:

I. Group I, claims 1-3 and 5-24, drawn to a first composition and method for coloring and highlighting hair, classified in Class 8, subclass 407.

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II. Group II, claims 25-68, drawn to a second composition for coloring and highlighting hair, classified in Class 8, subclass 407.

B. The inventions are distinct, each from the other because of the following reasons:

I. Inventions of Groups I and II are distinct compositions. Prior art that would render obvious or anticipate one composition would not necessarily render obvious or anticipate the other composition. Specifically note, that the composition of Group I, claims 1-3 and 21-24, does not require a powder bleach composition comprising both a persulfate compound and at least one particulate filler, as required by the composition of Group II, claims 25-68.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention of Group I (i.e. claims 1-3 and 5-20 before the December 8, 2000 Amendment, Paper No. 7), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-68 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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***Claim Rejections - 35 USC § 112***

10. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitation "said **organic** persulfate" in lines 1-2 of claim 22. There is insufficient antecedent basis for this limitation in the claim. Claim 22 should be amended to recite "said **inorganic** persulfate" to provide proper antecedent basis. Appropriate correction and/or clarification is required.

***Claim Rejections - 35 USC § 102***

11. Newly added claims 21-24 are rejected under 35 U.S.C. 102(a) as being anticipated by Goldwell, DE 19721785, for the reasons of record found in the last Office action, Paper No. 3.

***Claim Rejections - 35 USC § 103***

12. Newly added claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldwell, DE 19721785, for the reasons of record found in the last Office action, Paper No. 3.

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13. Newly added claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldwell, DE 19721785, in view of Yoshihara, U.S. Patent No. 5,332,581, for the reasons of record found in the last Office action, Paper No. 3.

14. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henkel, DE 2,624,690, for the reasons of record found in the last Office action, Paper No. 3. Specifically, the examiner notes that applicant has amended claim 1 so as not to require a cationic surfactant.

#### *Response to Arguments*

15. Applicant's arguments filed December 8, 2000 have been fully considered but they are not persuasive.

Applicant argues that Goldwell discloses a composition which contains xanthan gum, whereas the current application discloses that a xanthene-based composition is not suitable for use by those with sensitive or chemically treated hair. However, the examiner asserts that the claims, as presently written, do not exclude xanthan gum.

Applicant further argues that the examiner has erroneously applied *In re Hack* and *In re Albertson* with respect to the patentable weight of the intended use of a claimed composition. However, the examiner maintains that the preamble is not accorded any patentable weight where it merely recites the intended use of the composition. See MPEP 2111.02.

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Applicant argues that the examiner has used hindsight to reconstruct applicant's invention with respect to the 103 obviousness rejection of claims 1-3, 5-14 and 16-20 over Goldwell. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Furthermore, the examiner asserts that Goldwell does indeed teach a working pH of the composition. Specifically, note page 12, lines 8-10, where Goldwell discloses that the ready-to-use mixtures have a pH value between 6-11, as required by applicant in the instant invention.

Applicant further argues that Goldwell clearly does not teach the aqueous composition necessary for the one step method and composition therefor which is disclosed and claimed in the instant application.. However, the examiner asserts that Goldwell does indeed teach an aqueous composition. Specifically, note page 12, claim 2, where Goldwell discloses that the composition contains water.

With respect to the examiner's combination of Goldwell and Yoshihara, applicant argues that these references are unrelated. In response to applicant's argument that Goldwell and Yoshihara are nonanalogous art, it has been held that a prior art reference must either be in the



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field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Goldwell and Yoshihara are in the field of hair care, and thus are clearly analogous. Furthermore, the examiner asserts that the selection of silicone oils is an obvious variant of Goldwell's teachings since such oils are conventionally used in care hair products, and have the added benefit of conditioning the hair, as taught by Yoshihara.

Applicant argues that Henkel does not teach the single composition claimed in the instant application. However, the examiner asserts that Henkel does indeed teach a single composition, since Henkel discloses that the separate components are combined to form a mixture prior to use (see abstract).

### *Conclusion*

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (703) 305-0728. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

BPM

Brian Mruk  
March 10, 2001

  
Mark Kopec  
Primary Examiner